

REMARKS

Applicant has carefully reviewed the Office Action mailed May 20, 2004, and offers the following remarks in response thereto.

Claims 1, 5-9, 12-19, 36, 39-45, 52, 55, and 57-69 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis in view of Anderson et al. (hereinafter referred to as "Anderson"). Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where in the combination of references each and every claim element is located. MPEP § 2143.03. Before references can be combined in an obviousness determination, the Patent Office must use analogous references. MPEP § 2141.01(a). A reference is considered to be analogous if it is within the same field of endeavor or if it is reasonably pertinent to the particular problem within which the inventor was concerned. *Id.* Something is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. *Id.* When the Patent Office assembles the analogous references into a combination, the Patent Office must do two things. First, the Patent Office must articulate a reason or a motivation to combine references. Second, the Patent Office must support the motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Initially, Applicant traverses the rejection because Abecassis is non-analogous art. Applicant's field of endeavor is providing network announcements in a telecommunications network. In contrast, Abecassis is related to the replaying of video components such as via a DVD player, a personal computer, a set top box, and/or a multimedia player (see Abecassis, col. 1, lines 6-13). While video components on a DVD may have an audio component, Abecassis is not concerned with a telecommunications network, and thus, fails the first part of the analogousness test. Likewise, Abecassis is not reasonably pertinent to an inventor trying to find a way to reduce network traffic by distributing network announcements from a central location, which is the problem with which the inventor of the present invention was concerned. That is, Abecassis would not logically commend itself to someone trying to find a way to reduce network traffic by distributing network announcements. No one concerned with distributing audio files in a network is going to look to a DVD player or a method of accessing DVDs for a solution to the problem. Since Abecassis does not logically commend itself to an inventor faced with

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Applicant's problem, Abecassis fails the second part of the analogousness test. Having failed both part of the analogousness tests, Abecassis is non-analogous and cannot be used in an obviousness determination. Since Abecassis cannot be used, the combination based on Abecassis is improper, and the rejection is not properly supported. Since the Patent Office has not presented a proper rejection, the claims are allowable.

Applicant further traverses the combination of Abecassis with Anderson. Specifically, the Patent Office opines that it would have been obvious to combine the teaching of Abecassis and Anderson because Anderson's teaching of network related announcements would allow announcement information to be transmitted to customers in real-time. This motivation is not compelling. Abecassis has no network related announcements, and thus, does not need to have announcements sent to customers in real time. Therefore, such functionality is not logically combined into Abecassis. Likewise, Anderson inherently allows the announcements to be sent to the customers in real time and would not need to be combined with Abecassis's DVD player to satisfy the combination. In short, the motivation does not compel the combination, and the combination is improper. Since the combination is improper and the references individually do not teach or suggest all the claim elements, the rejection is improper, and the claims are allowable.

Even if Abecassis is analogous and the combination is proper, points which Applicant does not concede, Abecassis does not teach at least one of the elements for which it is cited. Specifically, claim 1 recites an audio identifier. The Patent Office opines that this is taught at Abecassis, col. 10, lines 24-38 and 51-59. Applicant respectfully traverses this assertion. Abecassis, col. 10, lines 24-38 and 51-59 discusses the keys on the remote control unit and particularly the segment fast forward and the segment reverse keys, as well as the MARK key. Under no reasonable interpretation of these passages is there any teaching or suggestion of an audio identifier. The Patent Office also points to col. 23, lines 33-38 of Abecassis. While this passage does discuss particular segments of video and how they are dealt with by an editor, the editor defines a content code level such as mature violence, teen violence, no violence. The content code level is not an audio identifier and cannot be used as such because multiple segments would have the same identifier. Thus, this cited passage does not teach or suggest an audio identifier. Since the reference does not teach or suggest the claim element, the combination of references does not teach or suggest the claim element, and the Patent Office has

not established *prima facie* obviousness. Since the Patent Office has not established obviousness for claim 1, claim 1 and its dependent claims 2-6 are allowable.

The Patent Office relies on its analysis of claim 1 to reject claim 7. Applicant's arguments about the analogousness of Abecassis and the impropriety of the combination are applicable to the rejection of claim 7. Claim 7 likewise recites the audio identifier, which, as explained above, is not shown by Abecassis. For these reasons, claim 7 and its dependent claims 8-11 are patentable.

The Patent Office relies on its analysis of claim 1 to reject claim 12. Applicant's arguments about the analogousness of Abecassis and the impropriety of the combination are applicable to the rejection of claim 12. For these reasons, claim 12 and its dependent claims 13-19 are patentable.

The Patent Office relies on its analysis of claim 1 to reject claim 36. Applicant's arguments about the analogousness of Abecassis and the impropriety of the combination are applicable to the rejection of claim 36. Claim 36 likewise recites the audio identifier, which, as explained above, is not shown by Abecassis. For these reasons, claim 36 and its dependent claims 37-39 are patentable.

The Patent Office relies on its analysis of claim 7 to reject claim 40. Applicant's arguments about the analogousness of Abecassis and the impropriety of the combination are applicable to the rejection of claim 40. Claim 40 likewise recites the audio identifier, which, as explained above, is not shown by Abecassis. For these reasons, claim 40 and its dependent claim 41 are patentable.

The Patent Office relies on its analysis of claims 1, 5, 6, and 14 to reject claim 43. Applicant's arguments about the analogousness of Abecassis and the impropriety of the combination are applicable to the rejection of claim 43. For these reasons, claim 43 and its dependent claims 44 and 45 are patentable.

The Patent Office relies on its analysis of claim 1 to reject claim 52. Applicant's arguments about the analogousness of Abecassis and the impropriety of the combination are applicable to the rejection of claim 52. Claim 52 likewise recites the audio identifier, which, as explained above, is not shown by Abecassis. For these reasons, claim 52 and its dependent claims 53 and 54 are patentable.

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The Patent Office relies on its analysis of claim 7 to reject claim 55. Applicant's arguments about the analogousness of Abecassis and the impropriety of the combination are applicable to the rejection of claim 55. Claim 55 likewise recites the audio identifier, which, as explained above, is not shown by Abecassis. For these reasons, claim 55 and its dependent claims 56-58 are patentable.

The Patent Office relies on its analysis of claim 12 to reject claim 59. Applicant's arguments about the analogousness of Abecassis and the impropriety of the combination are applicable to the rejection of claim 59. Claim 59 likewise recites the audio identifier, which, as explained above, is not shown by Abecassis. For these reasons, claim 59 is patentable.

The Patent Office relies on its analysis of claim 1 to reject claim 60. Applicant's arguments about the analogousness of Abecassis and the impropriety of the combination are applicable to the rejection of claim 60. Claim 60 likewise recites the audio identifier, which, as explained above, is not shown by Abecassis. For these reasons, claim 60 and its dependent claims 61 and 62 are patentable.

The Patent Office relies on its analysis of claims 1, 5, and 6 to reject claim 63. Applicant's arguments about the analogousness of Abecassis and the impropriety of the combination are applicable to the rejection of claim 63. Claim 63 recites a parameter for identifying the audio data segments, which is analogous to the audio identifier argued above. This element is not shown by the combination. For these reasons, claim 63 and its dependent claims 64-66 are patentable.

The Patent Office relies on its analysis of claims 1 and 5-7 to reject claim 67. Applicant's arguments about the analogousness of Abecassis and the impropriety of the combination are applicable to the rejection of claim 67. Claim 67 likewise recites the audio identifier, which, as explained above, is not shown by Abecassis. For these reasons, claim 67 and its dependent claims 68 and 69 are patentable.

Claims 2-4, 10, 11, 37, 38, 53, 54, and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis in view of Anderson and further in view of Kalmanek, Jr. et al. (hereinafter referred to as "Kalmanek"). Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the rejection because Abecassis remains non-analogous art as explained above. Applicant also traverses the rejection because, as explained above, the

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motivation to combine the references is non-compelling and the combination is improper. Applicant further traverses the rejection because the combination of Kalmanek is not properly supported. Specifically, the Patent Office opines that it would be obvious to combine Kalmanek's MGCP to provide devices to communicate in a more efficient manner. This asserted motivation is not supported with the requisite evidence that the Federal Circuit requires. To this extent, the combination is improper, and the Patent Office has not established obviousness.

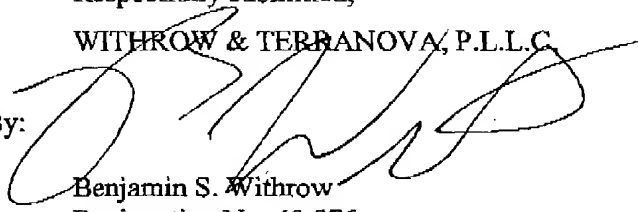
Applicant still further traverses the rejection because the addition of Kalmanek does not cure the underlying deficiencies of the combination of Abecassis and Anderson. Since the combination of references still does not teach or suggest an element, the Patent Office has not established obviousness, and the claims are allowable.

Applicant requests reconsideration of the rejection in light of the remarks presented herein. The Patent Office has used an improper reference which does not show all the claim elements in constructing a rejection. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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